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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/522,928 | 01/24/2005 | Ichiro Sato | TIP 031 | 6652 |
| 23408 7590 05/13/2008 GARY C. COHN, PLLC P. O. Box 313 Huntingdon Valley, PA 19006 | | | | |
| EXAMINER | | | | |
| BUTTNER, DAVID J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1796 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 05/13/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

garycohn@seattlepatent.com

Office Action Summary

Application No.

10/522,928

Applicant(s)

SATO, ICHIRO

Examiner

David Buttner

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-18 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 8/23/07

The lined out reference on the 1449 form as well as its machine translation are already of record.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 cannot depend from itself.

Claims 1-7 and 11-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Umeyama EP1188792 in view of JP2001200151.

Umeyama exemplifies (tables 3-11) blends of polycarbonate, branched polymethylphenylsiloxane, a sulfonate salt and PTFE. The polymethylphenylsiloxane has a high degree of branching and a high amount of phenyl groups (table 1). The blends may additionally include phosphorous flame retarders (paragraph 34). Phosphazene flame retarders are not named.

Phosphazene flame retarders are known to be effective in polycarbonates when used in combination with sulfonate salts or polymethylphenylsiloxanes (see table of JP2001200151). The phosphazene would be also effective when used with both polysiloxane and organic salt (paragraph 83 of JP2001200151).

It would have been obvious to use a phosphazene flame retardant as the phosphorous flame retardant called for by Umeyama. An improvement in flame retardancy would be expected.

Claims 8-10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Adding titanium dioxide and poly(organohydrogensiloxane) in addition to including a phosphazene compound in the EP1188792 composition is not reasonably suggested.

Applicant's arguments filed 8/23/07 have been fully considered but they are not persuasive.

Applicant argues that any potential obviousness of utilizing a phosphazene as the phosphorus flame retardant called for by EP1188792 would be overcome by applicant's data.

This is not convincing. The data shows better impact strength when using a phosphazene rather than a phosphate flame retardant in polycarbonate compositions. However, JP2001200151 already recognized the shock resistance (impact strength) problems associated with phosphate flame retardants in polycarbonates (paragraph 9). Presumably, phosphazenes do not have a detrimental effect on the mechanical properties (paragraph 13). Furthermore, JP2001200151 actually exemplifies the successful combination of polymethylphenylsiloxane (albeit not branched), sulfonate salt and phosphazene to flame retard polycarbonate. This is a strong indicator that the proposed rejection of utilizing phosphazene in EP1188792's PC, branched polymethylphenylsiloxane, sulfonate salt, PTFE composition would have been expected to be effective.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

5/7/08

/David Buttner/

Primary Examiner, Art Unit 1796